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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,815	09/29/2003	Kenneth W. Bair	RYL 2 0535-3-3-2-1-1	2219
7590 04/15/2004				
Jay F. Moldovanyi FAY, SHARPE, FAGAN, MINNICH & McKEE, LLP Seventh Floor 1100 Superior Avenue Cleveland, OH 44114-2518			EXAMINER TILL, TERRENCE R	
			ART UNIT 1744	PAPER NUMBER
DATE MAILED: 04/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/673,815	Applicant(s) BAIR ET AL.	
	Examiner Terrence R. Till	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-60 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15, 21, 23, 24, 30, 44, 46, 47, 49, 50 and 57 is/are rejected.
- 7) ☒ Claim(s) 22, 25-29, 31-43, 45, 48, 51-56 and 58-60 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/6/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Information Disclosure Statement***

1. The information disclosure statement filed 9/29/2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Applicant has provided copies of related applications IDS statements. Applicant should give un-initialed copies of the prior IDS' (PTO-1449's) for the examiner to initial. The IDS submitted has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 36 of U.S. Patent No. 6,260,234. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the '234 patent refers to a base portion including a suction source whereas claim 15 of the application recites a nozzle section. Absent this distinction, the scope of claim 36 of the '234 patent is broader than the scope of claim 15. It would have been obvious to a person skilled in the art at the time the invention was made to recognize that the terms "base portion" and "nozzle section" are synonymous.

4. Claims 21 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,353,963 in view of Yonkers. Claim 7 of patent '963 is considered to encompass the same subject matter, claiming a "lid" which is synonymous with the term "closure" recited in claim 21 of the application, but lacks the recitation of the suction source located beneath the dirt cup. The patent to Yonkers discloses a vacuum cleaner similar to that recited in the claims and further discloses a suction source 16 located beneath the dirt cup 15. It would have been obvious to a person skilled in the art at the time the invention was made to modify the suction source of claim 7 of patent '963 to be located beneath the dirt cup in view of the teaching of Yonkers, as such a layout is quite common throughout the art. With respect to claim 23, although claim 7 does not recite a conduit facilitating fluid communication between the suction opening and the dirt cup, Yonkers does show such a conduit as indicated by reference character 81 in figure 8. It would have been obvious to a person skilled in the art at the time the invention was made to provide a conduit facilitating fluid communication between the suction opening and the dirt cup to claim 7 of patent '963 in view of the teaching of Yonkers, as such a layout is necessary for the claimed device to function.

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5. Claims 21, 23 and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31 and 39 of copending Application No. 10/094,675 (allowed) in view of Yonkers. Claim 31 of application 10/094,675 is considered to encompass the same subject matter, claiming a "lid" which is synonymous with the term "closure" recited in claim 21 of the application, but lacks the recitation of the suction source located beneath the dirt cup. The patent to Yonkers discloses a vacuum cleaner similar to that recited in the claims and further discloses a suction source 16 located beneath the dirt cup 15. It would have been obvious to a person skilled in the art at the time the invention was made to modify the suction source of claim 31 of application 10/094,675 to be located beneath the dirt cup in view of the teaching of Yonkers, as such a layout is quite common throughout the art. With respect to claim 23, although claim 31 of 10/094,675 does not recite a conduit facilitating fluid communication between the suction opening and the dirt cup, Yonkers does show such a conduit as indicated by reference character 81 in figure 8. It would have been obvious to a person skilled in the art at the time the invention was made to provide a conduit facilitating fluid communication between the suction opening and the dirt cup to claim 31 of 10/094,675 in view of the teaching of Yonkers, as such a layout is necessary for the claimed device to function. Lastly, with respect to claim 24 of the application, claim 39 of application 10/094,675 recites the language verbatim.

6. This is a provisional obviousness-type double patenting rejection.

7. Claim 30 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 36 of U.S. Patent No. 6,260,234 in view of McCormick. Claim 36 of the '234 patent discloses most of the recited subject matter with the

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filter of claim 36 corresponding to the first filter mentioned in claim 30. What claim 36 of the '234 patent does not disclose is a second HEPA filter downstream of the suction source. The patent to McCormick discloses a vacuum cleaner similar in construction to that claimed in claim 30 of the application and further discloses a HEPA filter 50 downstream of the suction source. It would have been obvious to a person skilled in the art at the time the invention was made to provide a HEPA filter to claim 36 of the '234 patent in view of the teaching of McCormick in order to capture all dust particles that are drawn into the vacuum cleaner recited in claim 36.

8. Claims 44, 46, 47, 49 and 50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36 and 37 of U.S. Patent No. 6,260,234 in view of Yonkers and McCormick. Claim 36 of the '234 patent discloses most of the claimed subject matter presented in claim 44 with exception of a particle collecting chamber that includes a longitudinal axis, an entrance to said chamber being oriented approximately normal to the longitudinal axis and an exit from the particle collection chamber being oriented parallel to the longitudinal axis. It should be noted that claim 36 of the '234 patent inherently has a particle collecting chamber (the dirt cup). The patent to Yonkers discloses a vacuum cleaner similar to that recited in the claims and further discloses a particle collecting chamber 89 that includes a longitudinal axis, an entrance to said chamber 86 being oriented approximately normal to the longitudinal axis and an exit from the particle collection chamber 88 being oriented parallel to the longitudinal axis. It would have been obvious to a person skilled in the art at the time the invention was made to provide a particle collecting chamber that includes a longitudinal axis, an entrance to said chamber being oriented approximately normal to the longitudinal axis and an exit from the particle collection chamber

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being oriented parallel to the longitudinal axis to claim 36 of patent '234 in view of the teaching of Yonkers, as such a layout is typical when using cyclonic action to separate debris from an airstream. Although cyclonic separation is not mentioned in the claims, the disclosures of both the '234 patent and the application teach that and only that. With respect to claims 46 and 47, claim 37 of the '234 patent mentions that the filter is removable from the dirt cup and that the dirt cup and filter are movable as a unit relative to said upright housing.

9. With respect to claims 49 and 50, claim 36 of the '234 patent, as modified by Yonkers, does not disclose a final HEPA filter located downstream from the suction source. The patent to McCormick discloses a vacuum cleaner similar in construction to that claimed in claim 36 of the '234 patent and further discloses a HEPA filter 50 downstream of the suction source. It would have been obvious to a person skilled in the art at the time the invention was made to provide a HEPA filter to claim 36 of the '234 patent, as modified by Yonkers, in view of the teaching of McCormick in order to capture all dust particles that are drawn into the vacuum cleaner recited in claim 36.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 15 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Lessig III, et al.

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12. The patent to Lessig et al. discloses all the recited subject matter including a dirt cup 76, a filter support 84 and a filter element 82 mounted on the filter support, an inlet 74,80 radially displaced from a longitudinal axis of the particle collecting chamber (area in the dirt cup) and an axial outlet (upper opening of the cup, see figure 3).

Allowable Subject Matter

13. Claims 22, 25-29, 31-43, 45, 48, 51-56 and 58-60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Dyson, Conrad and Notetry show vacuum cleaners with cyclonic separation. The patents to Weglin et al. and UK patent to Hill et al. show vacuums with a filter disposed in the dirt cup or a filter that is part of the dirt cup.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terrence R. Till whose telephone number is (571) 272-1280. The examiner can normally be reached on Mon. through Thurs. and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Terrence R. Till
Primary Examiner
Art Unit 1744

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